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**EXAMINER**

J. A. GOLDBECK, J.

**ART UNIT****PAPER NUMBER**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 19

Application Number: 08/421,055

Filing Date: 04-12-95

Appellant(s): Michael A. Johnson, et al.

James V. Lilly, Esquire  
For Appellant

29 MAY 1997

**EXAMINER'S ANSWER**

This is in response to appellant's brief on appeal filed 24 FEBRUARY 1997.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

Art Unit: 1301

The statement of the status of the claims contained in the brief is correct. This statement is correct as far as it goes; however, it should also have indicated/recited that claims 1-5 have been cancelled.

This appeal involves claims 6-32.

Claims 18-19 were amended subsequent to the final rejection.

Claims 1-5 have been cancelled.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendments after final rejection filed on 26 AUGUST and 25 NOVEMBER 1996 (wherein the bracketed material in claim 18-19 (Amended) is incorrect) have been entered.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: stated slightly differently, the issues in this appeal are seen to be (1) Whether claims 6-32 are unpatentable under 35 USC 112, first paragraph, as not being (completely) supported by the disclosure; (2) Whether claims 14-15 and 29-31 are further unpatentable under 35 USC 112, first paragraph, as being not completely enabled by the disclosure/specification ie the enablement provided by the specification is not commensurate with the

Art Unit: 1301

claims as presented; (30) Whether claims 6-8, 16, 20-26 and 32 are further unpatentable under 35 USC 102 (b) as anticipated by or, in the alterative, under 35 USC 103 as obvious over WAGNER et al; (4) Whether claims 10-13 are further unpatentable under 35 USC 103 over WAGNER et al in view of PLETCHER; (5) Whether claims 9 and 28 are further unpatentable under 35 USC 103 over WAGNER et al in view of SCHAPPERT et al; and (b) Whether claims 17-19 and 27 are further unpatentable under 35 USC 103 over WAGNER et al in view of KAN.

**(7) *Grouping of Claims***

The rejection of claims 6-32 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7). Indeed, appellants Brief (N.B. page 4 line 15) clearly states that "The rejected claims stand or fall together".

**(8) *ClaimsAppealed***

A substantially correct copy of appealed claim 15 appears on page 2 of the Appendix to the appellant's brief. The minor errors are as follows: the term "partially cured" should have been deleted, as per the amendment filed 26 AUGUST 1996. All of the remaining claims are correctly transcribed.

**(9) *Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Art Unit: 1301

3,8376,984	WAGNER et al	24 SEPTEMBER 1974
4,059,715	PLETCHER	22 NOVEMBER 1977
4,822,683	SCHAPPERT et al	18 APRIL 1989
4,631,233	KAN	23 DECEMBER 1986

**(10) *New Prior Art***

No new prior art has been applied in this examiner's answer.

**(11) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 6-32 stand rejected under 35 USC 112, first paragraph, as being not (completely) supported by the disclosure.

Claims 14-15 and 29-31 stand further rejected under 35 USC 112, first paragraph, as being not completely enabled by the disclosure.

Claims 6-8, 16, 20-26 and 32 stand further rejected under 35 USC 102 as anticipated by or, in the alternative, under 35 USC 103 as obvious over the teachings of the U.S. Patent to WAGNER et al.

Claims 10-13 stand further rejected under 35 USC 103 as unpatentable over the teachings of the U.S. Patents to WAGNER et al in view of PLETCHER.

Art Unit: 1301

Claims 9 and 28 stand further rejected under 35 USC 103 as unpatentable over the teachings of the U.S. Patents to WAGNER et al in view of SCHAPPERT et al.

Claims 17-19 and 27 stand further rejected under 35 USC 103 as unpatentable over the teachings of the U.S. Patents to WAGNER et al in view of KAN.

**(12) *New Ground of Rejection***

This examiner's answer does not contain any new ground of rejection.

**(13) *Response to argument***

WAGNER et al (U.S. 3,837,984) disclose that it is known that adhere a composite tape composed of an (apparently dimensionally stable) support film coated on one side with a heat softenable adhesive to a surface of an automobile. (Fig. 3, abstract, col. 2 lines 16-19, 33-35, 43-46 and 63-67, col. 3 lines 60-64, col 4 lines 41-47, col. 6 lines 34-38).

PLETCHER (U.S. 4,059,715) discloses that, in the construction of adhesive (eg. tape) composites of the type/similar those of WAGNER et al, it is known to employ as the material of construction of the backing/base layer thereof, in addition to polyurethane, polyesters (eg. mylar), polyolefins (to include foams) etc. (N.B. col. 8 lines 57-68).

SCHAPPERT et al (U.S. 4,822,683) disclose that epoxy-polyester blends are known to be employed as adhesives in the bonding of automobile components. (Abstract, col. 1 lines 10-11 and 61-68, col. 2 line 1 thru col. 3 line 8, N.B. col. 6 lines 30-41).

KAN (U.S. 4,631,233) discloses that it is both known and desirable to apply a latex (which term is held/seen to encompass (latex) paint within its scope and definition) film to a

Art Unit: 1301

plastic substrate, a reactive/chemical bond being formed between film and substrate. (abstract, col. 1 lines 6-29, col. 2 lines 36-42, col. 5 lines 12-51).

Regarding the first non-art rejection, the Examiners position is that the specification, as originally filed, does not provide support for the invention as is now claimed. Specifically, there is no apparent support in the specification for the limitation in the claims requiring the dimensionally stable film to have a preselected surface topography (as set forth in independent claims 6 and 28-29); further along this line, appellants reliance upon page 7 lines 8-17 and page 27 lines 17-19 of the specification to establish other than a smooth surface for this film is held/seen to be misplaced, in that the former section deals with a cut out SHAPE rather than with a surface topography, while the latter section clearly describes this film as possessing a smooth surface; still further (and contrary to appellants contention), page 28 lines 9-22 are apparently unconcerned with/unconnected to the issue of topography. This rejection could be considered to be a new matter rejection.

With respect to the second non-art rejection, the Examiners position is that the disclosure is enabling only for claims limited in accordance with appellants specification at page 27 lines 10-22, which section clearly indicates that, when employed as the dimensionally stable (film) layer, the epoxy-polyester blend must be fully thermoset/crosslinked. Further along this line (and contrary to appellants contentions), the following are additionally advanced : (1) a partially crosslinked material is held/seen to be accurately described/characterized as (still) "thermosetting" or "thermosettable" but not as being "thermoset" (ie fully crosslinked);

Art Unit: 1301

and (2) appellants reliance upon page 29 lines 23-27 of their specification in this regard has been noted; however, it is further noted that the composition of neither the curable coating (which forms the coated film) nor the more stable (thermoset?) film are specified therein.

Regarding the first art rejection, the Examiners position is that any differences which might possibly/conceivably exist between this envisioned, claimed invention and the teachings of this reference are held/seen NOT to constitute patentable differences, with the following being additionally advanced: (1) there is apparently nothing presently of record to establish that the support/backing films of Wagner et al are not dimensionally stable in the manner envisioned/defined by appellants; further along this line, Wagner et al clearly provide for the use of polyurethane such film (N.B. col 2 lines 16-19, and compare with appellants specification at page 27 lines 10-22 and especially line 16), which film need NOT necessarily be thermoplastic (as contended by appellants - N.B. col 3 lines 71-73 of these patentees), <sup>or</sup> d (2) further contrary to appellants contention WRT Wagner et al, compare the indicated sections of this reference with page 6 lines 11-21 of appellants specification; further along this line, the thermosetting adhesive employed by these patentees is held/seen to be initially advanced to no further than B-stage (which is held/seen to indicate/provide for the occurrence of at least some flow at elevated temperature, prior to the attainment of full (ie C-stage) cure).

With respect to the second art rejection, the Examiner's position is that it would have been obvious to one of ordinary skill in this art to employ any of the conventional, documented backing layer materials disclosed in PLETCHER in the invention/tape of

Art Unit: 1301

WAGNER et al in place of the corresponding, analogous support (ie backing) layer employed therein; mere substitution of one known backing material for another involved. Further along this line, there is (as in the immediately preceding paragraph) apparently nothing presently of record to establish that the support/backing films of PLETCHER (which are held/seen to be the same types of materials envisioned for use by appellants ie compare col 8 liens 57-68 of this reference with page 27 lines 10-17 and page 29 lines 6-7 of appellants specification) are not dimensionally stable in the manner envisioned/defined by appellants.

With regard to the third art rejection, the Examiners position is that it would have been obvious to one of ordinary skill in this art to employ the conventional, documented adhesive disclosed in SCHAPPERT et al in the invention/tape of WAGNER et al in place of the corresponding analogous adhesive employed therein; mere substitution of one known automotive adhesive for another involved.

Regarding the fourth art rejection, the Examiners position is that it would have been obvious to one of ordinary skill in this art to employ the documented beneficial/DESIRABLE procedure of KAN in conjunction with the invention of WAGNER et al. (ie the exposed support layer thereof) wherever deemed appropriate.

With each of the three foregoing combination art rejections under 35 USC 103 (a) it is the sum total of the teachings of the applied, combined references taken as a whole which is held to render appellants invention obvious to one of ordinary skill in this art (In re McLaughlin 170 USPQ 209), and therefore appellants piecemeal attack on the references

Art Unit: 1301

individually can not establish unobviousness, since these rejections are based upon a combination of references (In re Mapelsden 141 USPQ 30); and (b) sufficient suggestion is held/seen to indeed be present in the applied references themselves to enable their proper and tenable combination as set forth in these respective rejection statements.

CONCLUSION:

For the reasons set forth above, the Examiner submits that the application of the applied (and, where indicated, combined) prior art references renders appellants invention as claimed obvious to one of ordinary skill in this art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **J.J. GALLAGHER** whose telephone number is (703) 308-1971. The examiner can normally be reached on M-F from approximately 8:30 A.M. to 5 P.M. The examiner can also be reached on alternate N/A.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL BALL, can be reached on (703) 308-2058. The fax phone number for this Group is (703) 305-7115.

Art Unit: 1301

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0651.

J.J. GALLAGHER/om  
May 15, 1997  
R-22-97

James V. Lilly, Esquire  
3M Office of Intellectual Property Counsel  
P.O. Box 33427  
St. Paul MN 55133-3427

  
JOHN J. GALLAGHER  
PRIMARY EXAMINER  
ART UNIT 131